



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Group Art Unit: 1722

MORIZANE et al.

Application No.: 09/772,994

Examiner: B. Mutschler

Filed: January 31, 2001

Docket No. 107336-00016

For: SOLAR CELL MODULE

SUBMISSION OF TERMINAL DISCLAIMER

Commissioner for Patents
Washington, D. C. 20231

Date: December 16, 2002

Sir:

Submitted herewith for filing in the above-identified application, is a Terminal Disclaimer.

Please charge Deposit Account No. 01-2300 in the amount of One Hundred Ten Dollars (\$110.00) to cover the cost of the fee. If any additional fees are due with respect to the filing of this paper, please charge Deposit Account Number 01-2300 and reference Attorney Docket No. **107336-00016**.

Respectfully submitted,
ARENT FOX KINTNER PLOTKIN & KAHN PLLC

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Enclosure: Terminal Disclaimer

SUBJECT DECISION ON TERMINAL DISCLAIMER INFORMAL FORM

DATE: 12.26.02

APPL. S.N.: 09/772,994

EXAMINER: BIM 1/3/2003

ART UNIT: 1722

PARALEGAL: BRIAN HARDEN

MAILROOM DATE: 12.16.02

AFTER FINAL: YES ☐ NO ☒

NUMBER OF T.D.(S) FILED: 1

INSTRUCTIONS: I have reviewed the submitted T. D. with the results as set forth below. If you agree, please use the appropriate form paragraphs identified by this informal memo in your next office action to notify applicant about the T. D. If you disagree any analysis or have questions at all about the acceptability of the T.D., please see our Special Program Examiner or me.

THIS MEMO IS AN INFORMAL, INTERNAL MEMO ONLY. IT MUST NOT BE MAILED TO APPLICANT, NOR SHOULD A COPY BE LEFT IN FILE. WHEN YOUR OFFICE ACTION IS COMPLETED, YOU MUST INITIAL AND DATE & RETURN THIS TO PARALEGAL.

☒ The T. D. is PROPER and has been recorded. (See 14.23)

☐ The T.D. is NOT PROPER and has not been accepted for the reason(s) checked below. (See 14.24)

☐ The recording fee of \$ has not been submitted nor is there any pre authorization in the application to charge to a deposit account. (See 14.25)

☐ Application Examiner has not processed fee for T. D.

☐ The T.D. does not satisfy Rule 321(b)(3) in that the person who has signed the T. D. has not stated his/her interest and the extent of the interest of the business entity represented by the signature in the application/patent. (See 14.26)

☐ The T. D. lacks the enforceable only during the common ownership clause needed to overcome a double patenting Rule 321(c). (See 14.27 and 14.27.1)

☐ T. D. is directed to a particular claim(s), which is not acceptable since the disclaimer must be of a terminal portion of the entire patent to be granted, MPEP 1490. (See 14.26 and 14.26.2)

☐ The person who signed the terminal disclaimer:

☐ has failed to state his/her capacity to sign for the business entity. (See 14.28)

☐ is not recognized as an officer of the assignee. (See 14.29.1)

☐ No documentary evidence of a chain of title from the original inventor(s) to assignee has been submitted, nor is the frame specified as to where such evidence is recorded in the office. 37CFR 3.73(b). (See 1140 O.G. 72) NOTE: This documentary evidence or the specifying of the reel and frame may be found in the T.D. or in a separate paper submitted by applicant. (See 14.30)

☐ No "STATEMENT" specifying that the evidentiary documents have been reviewed and that, to the best of the assignee knowledge and behalf the file is in the assignee seeking to take action 37 CFR 3.73(b). (See 1140 O.G. 72)

☐ The T. D. is not signed (See 14.26 and 14.26.3)

☐ Attorney is not of record in the oath/declaration or a separate paper filed appointing a new or associate attorney, nor is there a customer number.

☐ The serial number of the application (or the number of the patent) which forms the basis for the double patenting is missing or incorrect. (See 14.32)

☐ The serial number of this application (or the number of the patent in reexam or reissue case(s) being disclaimed is missing or incorrect. (See 14.26, 14.26.4 or 14.26.6)

☐ The period disclaimed is incorrect or not specified. (See 14.27, 14.27.2 or 14.27.3)

☐ Other _____



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Group Art Unit: 1722

Serial No.: 09/772,994

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Attorney Docket No. 107336-00016

For: SOLAR CELL MODULE

#12
(BA)

TERMINAL DISCLAIMER UNDER 37 C.F.R. 1.321(b)

Assistant Commissioner for Patents
Washington, D. C. 20231

Sir:

Petitioner, Sanyo Electric Co., Ltd., having its place of business at **5-5, Kaihanhondori 2-chome, Moriguchi-shi, Osaka-fu, Japan**, represents that it is the assignee and owner of all right, title and interest in and to U. S. Patent Application Serial No. **09/772,094**, filed **January 31, 2001**, for **SOLAR CELL MODULE**, the assignment for the application being recorded in the Patent and Trademark Office on January 31, 2001 at Reel 011491, Frame 0521. Petitioner is also the assignee of all right, title, and interest in and to U. S. Patent Application Serial No. **09/788,339**, filed **February 21, 2001**, for **SOLAR CELL MODULE** the assignment for this application being recorded in the Patent and Trademark Office on February 21, 2001 at Reel 011557, Frame 0194.

Petitioner hereby disclaims the terminal part, if any, of any patent granted on application Serial No. **09/772,994**, which would extend beyond the expiration date of any patent granted on application Serial No. **09/788,339**. when issued, and hereby agrees that

any patent so granted on application Serial No. **09/772,994**, shall be enforceable only during such period that the legal title to such patent shall be the same as the legal title to any patent granted on application Serial No. **09/788,339** this agreement to run with any patent granted on application Serial No. **09/772,994**, and to be binding on its grantee, its successors, or assigns.

Petitioner does not disclaim any terminal part of any patent granted on the above-identified application prior to the expiration date of the full statutory term as presently shortened by any terminal disclaimer of any patent granted on application Serial No. **09/788,339** in the event that it later: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid, is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. 1.321(a), has all claims cancelled by a reexamination certificate, or is otherwise terminated prior to the expiration of its statutory term as presently shortened by any terminal disclaimer, except for the separation of legal title stated above.

The undersigned on behalf of petitioner, **Sanyo Electric Co., Ltd.**, hereby states and declares that I have the authority to execute this Terminal Disclaimer on behalf of the petitioner.

Respectfully submitted,

Sanyo Electric Co., Ltd.

Nagatoshi Sugihara
By: Nagatoshi Sugihara
General Manager
Title: Technology R & D Headquarters
Intellectual Property Department
Date: November 20, 2002